

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

060091.00457

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Name _____

Application Number:

10/575,275

Filed: April 11, 2006

First Named Inventor:

Hasse SINIVAARA

Art Unit: 2618

Examiner: Jain Ankur

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

/Peter Flanagan/

Signature

☐ Applicant/Inventor.☐ assignee of record of the entire interest.See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)_____
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Registration Number if acting under 37 CFR 1.34 _____ November 14, 2011

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 7231

Hasse SINIVAARA

Art Unit: 2618

Application No.: 10/575,275

Examiner: Jain Ankur

Filed: April 11, 2006

Attorney Dkt. No.: 060091.00457

For: SERVICE DISCOVERY IN A WIRELESS COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 14, 2011

Sir:

Applicant hereby submits this Pre-Appeal Brief Request for Review (PABRFR) of the rejection, in the Office Action dated July 14, 2011, of claims 1-20, 23-25 and 27-32 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,058,423 to Ahmavaara ("Ahmavaara"), in view of U.S. Patent Publication No. 2002/0059434 to Karaoguz *et al.* ("Karaoguz"). Applicant hereby appeals this rejection and submits this PABRFR because this rejection includes clear errors.

Clear Error 1: 103(c) Bars the Citation of Ahmavaara

Ahmavaara is a patent issued on June 6, 2006, later than the filing date of the present application (April 11, 2006). Therefore, Ahmavaara is citable as prior art (if at all) only under 35 U.S.C. 102(e), based on its § 371(c) date of May 9, 2002. However, at the time the invention was made, Ahmavaara and the present application were assigned, or under an obligation of assignment, to the same entity: Nokia Corporation. Therefore, 35 U.S.C. 103(c) prevents the citation of Ahmavaara against the present application to show obviousness. For at least this reason, the rejection cannot be maintained.

However, there are also clear errors as to the mapping of the prior art to the claims.

Clear Error 2: Mobile Network (in prior art) Does not Provide Indication of Services Available Via Short-Range Wireless Network

Claims 1, 27, and 32 recite that a mobile network indicates the availability of services of another kind of network, namely a short-range wireless network, and subsequent activity by the multimode terminal in response to the indication. Such disclosure cannot be found in the prior art of record. In Ahmavaara, the mobile network indicates the services available via the mobile network, and in Karaoguz, the short-range wireless network indicates the services available via the short-range wireless network. Ahmavaara and Karaoguz have each network providing an indication of its own services, not the services of another network of another kind. Thus, Ahmavaara and Karaoguz, individually or combined, do not disclose or suggest, at least, “receiving, **from a mobile network, an indication** at a multimode terminal operably connected to the mobile network, the indication **indicating that services may be locally available via at least one short-range wireless network** [and] **based on the indication**, collecting service information about services ... available through at least one short-range radio interface,” (emphasis added) as recited in claim 1 and similarly recited in independent claims 27 and 32 (as discussed in the Response filed April 14, 2011, at page 14).

There are simply no corresponding features in the prior art. The Office Action has, in essence, cited one prior art reference in which an indication is received from a mobile network regarding the mobile network’s services and another prior art reference in which an indication is received from a short-range wireless network about the short-range wireless network’s services. Neither of those configurations corresponds to what is recited in the independent claims.

Specifically, Ahmavaara describes a configuration in which the mobile network is used to transmit information on services available **via the mobile network** (not via a short-range wireless network). For instance, in column 3, lines 20-40, Ahmavaara describes that “suitably, the intermediate network is capable of transmitting to a mobile station an indication of one or a plurality of serving network entities and the communications services provided by each one. Preferably, in order to receive a desired service a mobile station is capable of determining one of the serving network entities indicated as providing that service and attempting to establish a connection with that serving network entity via the intermediate network.” Ahmavaara describes

that the information about the services available is transmitted via the same network that transmits the actual services (see also column 5, lines 6 and 15-30).

Karaoguz does not cure the deficiencies of Ahmavaara. Rather, Karaoguz describes that **information about services available via the short-range networks is obtained via the short-range networks**. In paragraph [0017], the IEEE 802.11b controller disclosed by Karaoguz corresponds to a WLAN controller. Thus, Karaoguz discloses a dual-mode controller for Bluetooth and WLAN short-range networks. Although Karaoguz describes that a “multimode controller 80 receives network information 88 indicative of whether the device is within range of a supported network” (Karaoguz, paragraph [0044]), Karaoguz does not disclose that this network information is received **from the mobile network**. Karaoguz instead describes that knowledge about **services available via short-range networks** is obtained **via the short-range networks**.

According to Karaoguz, the device itself informs the multimode controller of whether the device is within range of a supported network. In other words, according to Karaoguz, such network information is provided by the device, not by the mobile network. In particular, paragraph [0035] of Karaoguz provides that “each multi-mode communication device 30 or 34 determines whether it is within the area of coverage of a type of network that is supported by the multi-mode communication device” (Karaoguz, paragraph [0035]). Nowhere does Karaoguz disclose receiving an **indication indicating that services may be available via a short-range wireless network from the mobile network**. FIG. 4 of Karaoguz, and the corresponding sections of the description (paragraphs [0044]-[0050]), do not disclose that the “network information” is received from an outside source, such as the mobile network.

Furthermore, in the entire disclosure of Ahmavaara, the term “network” refers to services provided by Core Network (CN) nodes or domains via the UTRAN. As taught by Ahmavaara, the mobile station receives knowledge of services provided by CN nodes (domains) via the UTRAN nodes (BS and RNC nodes). A person of ordinary skill in the art can only conclude that the configuration of Ahmavaara can only mean that knowledge about services available is sent and received via the same transmission path as the actual services. Ahmavaara only discloses that the information about the services available is transmitted via the same network that

transmits the actual services (in Ahmavaara that network is the mobile network, which consists of the Core Network and the UTRAN, as disclosed in Figure 1 and its description.)

Likewise, FIG. 14 of Karaoguz discloses explicitly how the presence or absence of short-range networks (Bluetooth or 802.11) is detected, and the result of such detection is the “network information 88” shown in FIG. 4. In connection with FIG. 14, Karaoguz discloses that the detection of short-range networks (Blue-tooth or 802.11) is initiated in step 232: “In the absence of any network connection, the dual-mode controller initiates a new network scan request 232 every ‘CFP Maximum Duration’ per 802.11b MAC specification” (Karaoguz, paragraph [0086]). Because the “dual-mode controller,” which is an embodiment of the “multi-mode controller,” resides in the communication device (terminal), it is the terminal and not the mobile network that initiates the detection of short-range networks.

Paragraphs [0009]-[0010] and [0044] of Karaoguz do not describe receiving an indication indicating that services may be available via a short-range wireless network from the mobile network. FIG. 4 of Karaoguz, for instance, and paragraphs [0009]-[0010] and [0044], do not disclose that the “network information” is received from an outside source, such as the mobile network.

Therefore, for at least the reasons outlined above, Ahmavaara and Karaoguz, individually or combined, do not disclose or suggest all the claimed features of independent claims 1, 27, and 32.

An Office Action mailed January 14, 2011, had apparently acknowledged that Ahmavaara indicates that the information about the services is transmitted via the same network that transmits the actual service. The Office Action of January 14, 2011, had argued that this teaching is “irrelevant” because the terms “same” or “different” are not found in the claims. Applicant respectfully submits that the “mobile network” and “short-range wireless network” are two different types of networks, as can easily be seen from the specification (as well as from the phrases themselves). The background section of the present application defines and describes short-range wireless systems. In the summary section, mobile networks and short-range wireless systems are described as “alternative technologies.” Accordingly, necessarily the “mobile network” is different from the “short-range wireless network” as recited in claim 1.

Clear Error 3: “Based on the Indication” Absent from Prior Art

As discussed above, claim 1 recites that the multimode terminal takes a variety of actions, including collecting service information about the services “based on the indication.” There is no corresponding disclosure in the prior art. In particular, whether or not Karaoguz discloses the multimode terminal collecting service information, the multimode terminal does not do so “based on the indication,” provided from the mobile network. Thus, the combination of references does not disclose all of the features recited in claim 1 (or similarly recited in claims 27 and 32).

Claims 2-20, 23-25 and 28-31 are dependent upon claims 1 and 27, respectively. As such, claims 2-20, 23-25 and 28-31 should be allowed for at least their dependence upon claims 1 and 27, and for the specific limitations recited therein.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel’s Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: PTO/SB/33 Form
Notice of Appeal